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In re Patent No. 7,482,440	: DECISION ON APPLICATION FOR
Issued: January 27, 2009	: PATENT TERM ADJUSTMENT and
Application No. 10/006,265	: NOTICE OF INTENT TO ISSUE
Filed: December 3, 2001	: CERTIFICATE OF CORRECTION
Dkt. No.: 14875-0096001/C2-105DP1P	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed March 27, 2009.

The application for patent term adjustment (PTA) under 37 CFR 1.705(d) is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The above-identified application matured into U.S. Pat. No. 7,482,440 on January 27, 2009. The patent issued with a patent term adjustment of 362 days. The instant application was timely filed in accordance with 37 CFR 1.705(d).

Patentees request correction of the patent term adjustment from 362 days to 907 days. Patentees request this correction on the basis that the Office took in excess of three years to issue the above-referenced patent. Patentees further contest the adjustment of 76 days in connection with the issuance of the patent. Patentees further assert that the Office neglected to assess a reduction of 12 days in connection with the Information Disclosure Statement (IDS) filed July 10, 2008.

Patentees acknowledge the adjustment under 37 CFR 1.702(a)(1) of 679 days. Patentees contest the adjustment of 76 days in connection with the issuance of the patent. Patentees assert that the patent is entitled to 78 days in this regard as the issue fee was submitted July 10, 2008.

A review of the record reveals that patentees are correct in that the issue fee was received by the USPTO on July 10, 2008, and not July 12, 2008, as reflected by the previous calculation of adjustment. In view thereof, in accordance with 37 CFR 1.702(a)(4), the patent is entitled to an adjustment of 78 days, rather 76 days. The adjustment commenced November 11, 2008, the day after the date that is four months after the date that the issue fee was received, and ended January 27, 2009, the date that the patent issued. See, 37 CFR 1.703(a)(6).

In view thereof, the request for correction of the patent term adjustment under 37 CFR 1.702(a)(4) from 76 days to 78 days is **GRANTED.**

Patentees acknowledge the applicant delays totaling 393 days. Further, patentees assert that the Office neglected to assess a reduction of 12 days in connection with the Information Disclosure Statement (IDS) filed July 10, 2008.

The Office thanks patentees for their good faith and candor in bringing this to our attention. In accordance with 37 CFR 1.704(c)(10), the reduction in this regard is 12 days, as asserted by patentees. The reduction commenced July 10, 2008, the date that the IDS was filed and ended July 21, 2008, the date that the Office mailed a reply in response thereto. Accordingly, the overall reduction for applicant delay totals 405 days, as asserted by patentees.

In view thereof, the request for correction of the applicant delay pursuant to 37 CFR 1.704 from 393 days to 405 days is GRANTED.

Patentees argue that in view of Wyeth v. Dudas, Civil Action No. 07-1492, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. Sept. 30, 2008), the patent is entitled to an overall adjustment of 907 days (757 days pursuant to 35 USC 154(b)(1)(A) *plus* 565 days pursuant to 35 USC 154(b)(1)(B) *less* 10 overlapping days *less* 405 days of applicant delay).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the filing of the request for continued examination (RCE) on June 21, 2006, the application was pending three years and 564 days after its filing date (December 4, 2004 to June 20, 2006). The Office agrees that as of the filing of the RCE, certain action was not taken within the specified time frame, and thus, the entry of a period of adjustment of 679 days is correct. At issue is whether patentees should accrue 564 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 679 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 564 days of delay in issuing the patent overlaps with the 679 days of examination delay under 37 CFR 1.702(a). Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*¹ and of the *United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office

¹ Likewise, 37 CFR 1.703(f) provides that:

interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. *See* 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). *See Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). *See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), December 3, 2001, and ending on June 20, 2006, the day before the date that the RCE was filed on June 21, 2006.

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 679 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the RCE. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 564 days of patent term

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

adjustment accrued at the time of submission of the RCE for Office issuance of the patent more than three years after the application filing date.

The 564 days of patent term adjustment that accrued under 37 CFR 1.702(b) overlaps with the 679 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 564 days and the 679 days is neither permitted nor warranted given that 679 days is the actual number of days issuance of the patent was delayed at the time of submission of the RCE.

In view thereof, the request for an additional adjustment of 565 days pursuant to 37 CFR 1.702(b) is hereby DISMISSED.

In view thereof, at the time of issuance of the patent, the application was entitled to an overall patent term adjustment of 352 days (adjustments totalling 757 days (679 days pursuant to 37 CFR 1.702(a)(1) *plus* 78 days pursuant to 37 CFR 1.702(a)(4)) *less* applicant delays of 405 days).

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 352 days.

Any request for reconsideration of this decision must be submitted within ONE MONTH of the mail date indicated herein. The time period for seeking reconsideration is not subject to extension under 37 CFR 1.136.

Receipt is hereby acknowledged of the required patent term adjustment application fee of \$200.00.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.



Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,482,440 B2
DATED : January 27, 2009
INVENTOR(S) : Maeda, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 362 days

Delete the phrase "by 362 days" and insert – by 352 days--